

Application No. 09/925,881
Amendment dated December 28, 2004
Reply to Final Office Action dated October 28, 2004

REMARKS/ARGUMENTS

Applicants have carefully reviewed the Office Action mailed on October 28, 2004. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. With this amendment, claim 25 is amended. Claims 25 and 30-34 remain pending.

Claims 25, 30-31, and 34 are rejected under 35 U.S.C. §102(b) as being anticipated by Chan in U.S. Patent No. 5,234,002. Claim 25 is amended to more clearly define the claimed invention. The Examiner indicated that:

Chan discloses in figure 2, col. 3, lines 1-35 and lines 50-65, a threaded connection system is suitable for use in connecting extension wires and guidewire having the limitations of claims 25 and 34, including: a first wire (10) includes [sic] a body member. A female threaded member (18) disposes [sic] within the first end of the body member. A second wire (11) includes a second body member (17). An engagement structure (15) adapts to threadingly engaging [sic] the female thread of the first wire. The engagement structure is a male thread disposed about the body member of the second wire; and wherein a portion of the male thread of the first wire is adapted to deform or capable of altering the shape by pressure when the male thread threadingly engages the female thread of the first wire (as best seen in fig. 2).

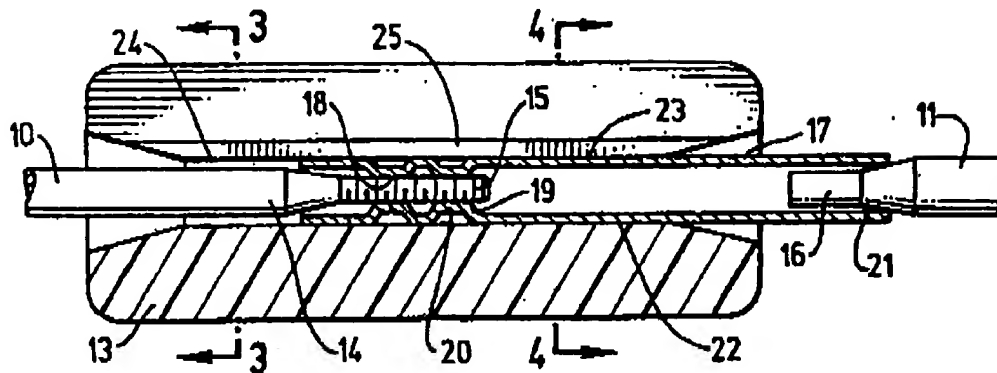
As we indicated in the previous reply, we do not believe that the Examiner has correctly characterized the art because structures and reference numbers contained within the above passage do not match with what is shown in Figure 2 or in the detailed description of Chan. For example, the Examiner indicated that Chan discloses that the first wire (10) includes a body member and that a female threaded member (18) is disposed within the first end of the body member.

Application No. 09/925,381

Amendment dated December 28, 2004

Reply to Final Office Action dated October 28, 2004

Figure 2 of Chan is inserted below for easy reference:



We do not understand how the Examiner can possibly say that "female threads (18)" are "disposed [sic] within the first end of the body member (of the first wire)". Clearly, "first wire (10)" and "female threads (18)" are different structures and the "female threads (18)" are not disposed within any part of the "first wire (10)". In fact, Chan explicitly states this at column 4, lines 40-46:

The distal end 16 of the extension wire 11 has a tubular member 17 with internal female threads 18 which are formed on the inner projecting surface 19 of the dimpled wall 20. As shown, the tubular member 17 is a separate member which is joined to the distal end of the extension wire by welding at location 21.

As explicitly stated, the tubular member 17 is a separate structure that is welded to extension wire 11 and is not part of wire 10. By virtue of being a separate structure, no reasonable interpretation can be relied upon to establish that tubular member 17 is part of wire 10. Moreover, the female threads 18 are a portion of the tubular member 17. Therefore, the Examiner's assertion that female threads 18 are a part of the first wire 10 makes no sense whatsoever and fails to follow the plain statements directly recited by Chan.

Application No. 09/925,881
Amendment dated December 28, 2004
Reply to Final Office Action dated October 28, 2004

The Examiner's mischaracterizations continue when the Examiner asserts that Chan discloses "[a] second wire (11)" and that "[t]he engagement structure is a male thread disposed about the body member of the second wire". Here it appears as though the Examiner is identifying a portion of wire 10 as being part of wire 11. We do not understand the Examiner's logic and cannot understand how the structures identified by the Examiner could possibly anticipate the claimed invention. We attempted to explain this situation in the last response. However, the Examiner apparently did not understand our response and has failed to provide adequate explanation for the grounds of rejection.

Finally, the Examiner asserted that the phrase "adapted to deform", as recited in claim 25, is an intended use. Accordingly, the Examiner indicated that recited language must result in a structural difference between the claimed invention and the art in order to patentably distinguish the claimed invention from the art. Again, we do not fully understand which structures in the art the Examiner is referring to. We believe that our recitation in claim 25 that "the male thread is adapted to deform when the male thread threadingly engages the female thread of the first wire" is structural in nature. Chan does not teach or disclose this limitation. Even disregarding the Examiner's mischaracterization of the art, Chan cannot anticipate claim 25 because Chan does not disclose that "the male thread of the first wire is adapted to deform when the male thread threadingly engages the female thread of the first wire". Therefore, claim 25 is clearly patentable over Chan.

Regarding claims 30-31, claim 30 recites that the male thread includes "a first portion and a second portion which is different from the first portion, the second portion adapted to be more deformable than the first portion when the male thread is threaded into the female thread". Two structurally distinct portions of the male thread are recited in claim 30. Chan simply does not include any teachings or discussion of these structural limitations.

The Examiner indicated that Chan discloses that the male thread includes two portions at col. 3, lines 50-65. Again, this statement is entirely incorrect. The cited passage of Chan discusses the female threads and has nothing to do with male threads. Therefore, the cited passage does not support the Examiner's position because it relates to a clearly different structure. In light of these remarks, claim 30 is clearly patentable over Chan. Because claim

Application No. 09/925,881
Amendment dated December 28, 2004
Reply to Final Office Action dated October 28, 2004

31 depends from claim 30, it is patentable at least for this reason and because it adds significant elements to distinguish it further from the art.

Regarding claim 34, this claim similarly recites that "the male thread including a first portion and a second portion that is different from first portion and that is adapted to deform when threadingly engaged with the female thread." As described above, these structures are not disclosed or taught by Chan. Therefore, claim 34 is clearly patentable over Chan.

Claims 32-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chan. As described above, claim 30 is distinguishable from Chan. Because claims 32-33 depend from allowable claim 30, they are also patentable based on these remarks and because they add significant elements to distinguish them from the art. Applicants respectfully submit that these remarks overcome the rejection under 35 U.S.C. §103(a).

In light of the fact that the Examiner has failed to fully explain the grounds of the rejection in a manner that can be reasonably understood, Applicants respectfully submit that it is improper for the present office action to be made final. MPEP §706.07 states that the grounds of a final rejection must "be clearly developed to such an extent that applicant may readily judge the advisability of an appeal". Given the fact that Applicants cannot trace the structures recited by the Examiner with the figures presented in the art, Applicants cannot readily judge the advisability of an appeal. Therefore, Applicants respectfully submit that a final rejection is not proper and that the holding of finality should be withdrawn in due course.

Application No. 09/925,881
Amendment dated December 28, 2004
Reply to Final Office Action dated October 28, 2004


Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

BRIAN K. BALZUM et al.

By their attorney,

Date: December 28, 2004


Scot Wickhem, Reg. No. 41,376

CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Telephone: (612) 677-9050
Facsimile: (612) 359-9349